



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,681	11/15/2001	Masahiro Honjo	2001-1710A	7533

513 7590 11/01/2006

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

SHIBRU, HELEN

ART UNIT PAPER NUMBER

2621

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/987,681

Applicant(s)

HONJO, MASAHIRO

Examiner

HELEN SHIBRU

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-14, 18-23, 26-28, 31-32 and 35, drawn to a recording and reproducing method including the feature of “a reading step... an information obtaining step of obtaining positional information which indicates positions of previous and subsequent data groups of a specific data group in the **read first MPEG** data with respect to said specific data group, on the **basis of the first MPEG** data; an information addition step of adding the positional information at a determined position in the **first MPEG data** to generate **second MPEG** data; and a recording step of recording the **second MPEG data** on a second recording medium”, classified in class 386, subclass 111.
 - II. Claims 2, 5, 8, 10, 13, 16-22, 24, 29, and 33, drawn to a recording/reproducing method including the feature of “a decoding step... a re-encoding step...; and a recording step of **recording the second MPEG** data on a second recording medium” classified in class 386, subclass 112.
 - III. Claims 3-4, 6-7, 9-11, 14-23, 25, 30, and 34, drawn to a recording/reproduction method including the feature of “a reading step...; a decoding step...; a re-encoding step...; an information obtaining step of obtaining positional information which indicates positions of previous and subsequent data groups of a specific data group in the **second MPEG data** with respect to said specific data group, on the **basis of the second MPEG** data; an information addition step of

adding the positional information at a determined position in the **second MPEG data**, to **generate third MPEG data**; and a recording step of recording the **third MPEG data** on a second recording medium”, classified in class 386, subclass 109.

Note that some of the dependent claims are included in one or more group because they depend on more than one independent claim.

2. The inventions as grouped above are distinct inventions not useable together. The three groups of inventions are useable apart from each other and have unique specific structures not required of the other, and can therefore be separately useable as distinct inventions. For example the recording/reproducing method as recited in claim 1 of group I does not require the features of “a decoding step of decoding the read first MPEG data to generate a decoded signal; a re-encoding step of re-encoding the decoded signal so as to make the amount of information smaller than that of the first MPEG data” as cited in page 49 lines 2-6 in claim 2 of group II, and an information obtaining step of obtaining positional information which indicates positions of previous and subsequent data groups of a specific data group in **the second MPEG data** with respect to said specific data group, on the **basis of the second MPEG data**; an information addition step of adding the positional information at a determined position in the **second MPEG data**, to **generate third MPEG data**; and a recording step of recording the **third MPEG data** on a second recording medium” as cited inn pages 49-50 of claim 1 of group III.

Moreover the recording/reproducing method as cited in claim 2 of group II does not require the features of “an information obtaining step of obtaining positional information which indicates positions of previous and subsequent data groups of a specific data group in the read

Art Unit: 2621

first MPEG data with respect to said specific data group, on the basis of the first MPEG data; an information addition step of adding the positional information at a determined position in the first MPEG data to generate second MPEG data; and a recording step of recording the second MPEG data on a second recording medium” as cited in page 48 lines 9-16 in claim 1 of group I, and “a recording step of recording the **third MPEG** data on a second recording medium” as cited in claim 3 of group III.

In addition the recording/reproducing method as cited in claim 3 of group III does not require the feature of “an information obtaining step of obtaining positional information which indicates positions of previous and subsequent data groups of a specific data group in the **read first MPEG** data with respect to said specific data group, on the **basis of the first MPEG** data; an information addition step of adding the positional information at a determined position in the **first MPEG data** to generate **second MPEG** data; and a recording step of recording the **second MPEG data** on a second recording medium” as cited in claim 1 of group I, and the feature of “a recording step of **recording the second MPEG** data on a second recording medium” as cited in claim 2 of group II.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

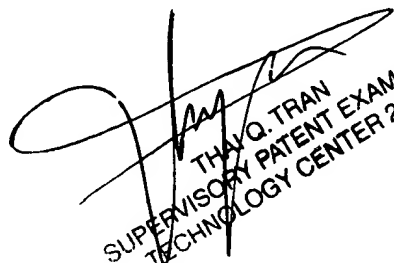
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHIBRU HELEN whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on 571 272 7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Helen Shibru

October 20, 2006


THAI Q. TRAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600